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In re Application of :
ROGELZ, Snezna, et al. :
U.S. Application No.: 09/424,181 :
PCT No.: PCT/US98/09795 :
International Filing Date: 14 May 1998 :
Priority Date: 14 May 1997 :
Attorney's Docket No.: None :
For: INHIBITION OF CELL SURFACE :
PROTEIN DISULFIDE ISOMERASE :

DECISION ON

This decision is issued in response to the "Petition To The Commissioner Under 37 CFR 1.181 and 1.48" filed on 02 June 2000. Applicants have been charged for the required petition fee.

BACKGROUND

On 14 May 1998, applicants filed international application PCT/US98/09795 which claimed a priority date of 14 May 1997 and which designated the United States.

On 07 December 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 15 November 1999 (14 November 1999 was a Sunday).

On 10 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States which indicates that it was accompanied by, among other materials: (1) a copy of the application; (2) a declaration; (3) a small entity statement; and (4) a check in the amount of \$48 as the basic national fee. A copy of the international application was not required because the international application was filed in the United States Receiving Office (RO/US).

On 04 May 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) and a Notification Of A Defective Oath Or Declaration (Form PCT/DO/EO/917) indicating that the submitted declaration was not in compliance with 37 CFR 1.497 because it included an inventor who was not present on the published international application. The Notifications also informed applicant that the failure to submit these materials within one month of the mail date of the Notifications would result in abandonment of the application.

On 02 June 2000, applicants filed a "Response" which included the petition considered herein. The petition seeks to add Robert B. Palmer as an inventor.

DISCUSSION

A petition under 37 CFR 1.48(a) to correct an error in naming inventorship requires: (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part; (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63; (3) the fee set forth in 37 CFR 1.17(I); and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b). As discussed below, applicants have satisfied items (2), (3) and (4), but have failed to satisfy item (1).

Regarding item (1), applicants have submitted a facsimile copy of a statement apparently executed by the added inventor, Robert B. Palmer. However, the section of the document which contains Mr. Palmer's statement is not legible and therefore does not satisfy this requirement. Applicants must submit a legible statement from Mr. Palmer in order to satisfy this requirement.

Regarding item (2), applicants had previously filed a declaration executed by the two inventors named in the international application and by the inventor sought to be added, Robert B. Palmer. Item (2) is therefore satisfied.

Regarding item (3), applicants have provided authorization to charge Deposit Account No. 10-0233 for required fees. Based on this authorization, Deposit Account No. 10-0233 has been charged the \$130 petition fee required under 37 CFR 1.17(I).

Regarding item (4), applicants have not recorded an assignment in this case, and no assignee is referred to in the petition. Pursuant to section 201.03(D) of the MPEP, it is therefore presumed that no assignee exists and that this requirement is inapplicable to the present application.

Based on the above, applicants have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.48(a). Accordingly, the petition cannot be granted in its current form,

and the declaration filed by applicants on 10 November 1999 remains defective for naming an inventor (Robert B. Palmer) who is not of record on this application.

CONCLUSION

Applicants' petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

Pursuant to applicants' authorization, Deposit Account No. 10-0233 has been charged \$130 as the petition fee.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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